

REMARKS

The present application was filed on January 2, 2001 with claims 1-17. In the outstanding Office Action dated March 25, 2004, the Examiner has: (i) rejected claim 9 under 35 U.S.C. §112, second paragraph as being indefinite; (ii) rejected claims 1, 4, 6-8, 10 and 12-17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,154,844 to Touboul et al. (hereinafter "Touboul '844"), in view of U.S. Patent No. 5,699,431 to Van Oorschot et al. (hereinafter "Van Oorschot"); (iii) rejected claims 2 and 3 under §103(a) as being unpatentable over Touboul '844 in view of Van Oorschot, in further view of U.S. Patent No. 6,092,194 to Touboul (hereinafter "Touboul '194"); (iv) rejected claim 5 under §103(a) as being unpatentable over Touboul '844 in view of Van Oorschot, and further in view of U.S. Patent No. 6,275,937 to Hailpern et al. (hereinafter "Hailpern"); (v) rejected claim 9 under §103(a) as being unpatentable over Touboul '844 in view of Van Oorschot in view of Hailpern in view of Touboul '194, and further in view of U.S. Patent No. 5,781,629 to Haber et al. (hereinafter "Haber"); and (vi) rejected claim 11 under §103(a) as being unpatentable over Touboul '844 in view of Van Oorschot, and further in view of U.S. Patent No. 6,233,577 to Ramasubramani et al. (hereinafter "Ramasubramani").

In this response, claims 1, 3, 5, 6, 8 and 9 have been amended. Applicants traverse the §103(a) rejections for at least the reasons set forth below. Applicants respectfully request reconsideration of the present application in view of the above amendments and the following remarks.

Claims 1, 3, 5, 6 and 8 have been amended to correct certain informalities which were discovered upon reviewing the present application. Claim 9, which presently stands rejected under §112, has been amended in a manner which Applicants believe addresses the §112 rejection. Accordingly, favorable reconsideration and allowance of claim 9 are respectfully solicited.

Claims 1, 4, 6-8, 10 and 12-17 stand rejected under §103(a) as being unpatentable over Touboul '844, in view of Van Oorschot. With regard to independent claim 1, as well as claims 13-17 which are of similar scope, the Examiner contends that Touboul '844 discloses all of the steps set forth in claim 1, except that Touboul '844 fails to teach that the virus-free certificate comprises a certificate signature (Office Action; page 3, paragraph 3 to page 4, paragraph 4). The Examiner further contends, however, that "including a certificate signature within a certificate is old and well

known in the art as shown by Van Oorschot” (Office Action; page 4, paragraph 3). Applicants disagree with the Examiner’s contentions that the claimed invention fails to distinguish over the prior art of record.

Specifically, Applicants submit that Touboul ‘844 fails to teach or suggest at least the step of “forwarding the file with the associated virus-free certificate” (emphasis added) if the file is determined to be virus-free, as required by claim 1. While Touboul ‘844 may disclose that “[i]f each DSP 215 passes, then the local security policy analysis engine 530 in step 770 instructs the retransmission engine 540 to pass the Downloadable” (Touboul ‘844; column 10, lines 16-18), Touboul ‘844 fails to teach or suggest forwarding the Downloadable along with an associated virus-free certificate. In contrast to the claimed invention, the Downloadable file which is passed to the computer client in step 770 (Touboul ‘844; Figure 7) is stripped of any inspector certificate in step 710. With reference to FIG. 7, Touboul ‘844, at column 9, lines 21-26, states:

Method 700 begins with the Downloadable file interceptor 505 in step 705 receiving a Downloadable file. The file reader 510 in step 710 extracts the Downloadable 150, and in step 715 instructs the certificate authenticator 515 to authenticate the developer certificate 155 as from a trusted developer 120. (emphasis added)

It is clear from the above disclosure that the Downloadable 150 passed along in step 770 only includes the Downloadable 205 and the developer certificate 155 (if present), as shown in FIG. 2, and fails to include a virus-free certificate (which the Examiner analogizes to the inspector certificate 170 in Downloadable 195) associated with the file, as explicitly set forth in claim 1.

Claim 1 is further distinguishable from Touboul ‘844 in that Touboul fails to teach or suggest at least the step of “associating with the file a new virus-free certificate, and forwarding the file with the new virus-free certificate” if the file is virus-free, as required by claim 1. Although the Examiner contends that this step is disclosed in step 635 (Touboul ‘844; FIG. 6), Applicants respectfully disagree with this contention. The method 600 disclosed in FIG. 6 of Touboul ‘844 is not performed in a virus-free certificate firewall (which the Examiner analogizes to the network gateway 110 shown in FIG. 1) and does not relate to controlling and filtering files using a virus-free certificate, as expressly required by claim 1. Rather, in contrast to the claimed invention, method 600 is

performed by the developer 120 and inspector 125, which is on the web server side of the network gateway 110, as clearly depicted in FIG. 1 of Touboul '844. Specifically, Touboul '844 states:

Method 600 begins with the developer 120 in step 605 obtaining or using the Downloadable development engine 140 to create a Downloadable 205. . . . The Downloadable development engine 140 in step 620 transmits the signed Downloadable 150 to the inspector 125. . . . The content inspection engine 160 in step 635 attaches the inspector certificate 170 to the file, thereby providing authentication of the attached DSP 215 (including the Downloadable ID 220). (Touboul '844; column 8, line 39 to column 9, line 4; emphasis added)

For at least the above reasons, Applicants assert that claims 1 and 13-17 are patentable over the prior art. Accordingly, favorable reconsideration and allowance of these claims are respectfully requested.

With regard to claims 4, 6-8, 10 and 12, which depend from claim 1, Applicants submit that these claims are also patentable over the prior art of record by virtue of their dependency from claim 1, which is believed to be patentable for at least the reasons set forth above. Moreover, one or more of these claims define additional patentable subject matter in their own right. For example, claim 8 further defines the step of determining whether the file is virus-free or not as comprising the step of "discarding the file" if the file is not virus-free. With regard to claim 8, the Examiner contends that Touboul '844 discloses such additional feature in step 765 of FIG. 7 (Office Action; page 5, paragraph 3). However, Applicants respectfully disagree with this contention and assert that Touboul '844 fails to disclose discarding any files that are not virus-free. Instead, Touboul discloses that "[i]f a DSP 215 fails, then the local security policy analysis engine 530 in step 765 stops the Downloadable and sends a substitute non-hostile Downloadable to the computer client 130 to inform the computer client 130 of the failure" (Touboul '844; column 10, lines 18-22). Nowhere does Touboul '844 disclose the disposition of the Downloadable which does not pass all DSPs, and sending a substitute non-hostile Downloadable is not reasonably analogous to discarding a file.

Likewise, claim 12 further defines the step of forwarding the file with the new virus-free certificate as including the step of "updating a cache with the new virus-free certificate." With regard to claim 12, the Examiner contends that Touboul '844 discloses updating a cache, which the Examiner analogizes to data storage device 330 in FIG. 3, with a new virus-free certificate, which

the Examiner analogizes to the signed Downloadable 150 in FIG. 2 (Office Action; page 6, paragraph 1). Applicants respectfully disagree with this contention and submit that, while Touboul '844 may disclose a data storage device 330 in which signed Downloadables 150 may be stored (Touboul '844; FIG. 3), Touboul '844 fails to teach or suggest any updating step performed by the virus-free certificate firewall itself, as required by claim 12. Rather, in contrast to claim 12, the signed Downloadable 150 stored in data storage device 330 is not analogous to the new virus-free certificate set forth in claim 12 since the Downloadable 150 has not been inspected and forwarded by the firewall at this point. Moreover, Touboul '844 fails to disclose updating a cache with the new virus-free certificate as part of the step of forwarding the file and associated new virus-free certificate (e.g., to a client workstation), as required by claim 12.

In view of the foregoing, Applicants submit that claims 4, 6-8, 10 and 12 are believed to be patentable over the prior art of record, not merely by virtue of their dependency from claim 1, but also in their own right. Accordingly, favorable reconsideration and allowance of claims 4, 6-8, 10 and 12 are respectfully solicited.

Claims 2 and 3 stand rejected under §103(a) as being unpatentable over Touboul '844 in view of Van Oorschot, in further view of Touboul '194. The Examiner acknowledges that the combination of Touboul '844 and Van Oorschot fails to teach the additional features set forth in claims 2 and 3 (Office Action; page 7, paragraph 4). However, the Examiner contends that such features are disclosed in Touboul '194. Although Applicants respectfully disagree with the Examiner's contentions in this regard, Applicants submit that claims 2 and 3, which depend from claim 1, are also patentable over the prior art of record by virtue of their dependency from claim 1, which is believed to be patentable for at least the reasons set forth above. Accordingly, favorable reconsideration and allowance of claims 2 and 3 are respectfully requested.

Claims 5, 9 and 11 stand rejected under §103(a) as being unpatentable over Touboul '844 and Van Oorschot, in further view of one or more of Hailpern, Touboul '194, Haber and Ramasubramani. With regard to claims 5, 9 and 11, which depend from claim 1, Applicants submit that these claims are also patentable over the prior art of record by virtue of their dependency from claim 1, which is believed to be patentable for at least the reasons set forth above. Moreover, one or more of these claims define additional patentable subject matter in their own right.

For example, claim 9 further defines the step of authenticating the virus-free certificate as comprising the steps of validating the virus-free certificate, the virus-free certificate including a list of one or more anti-virus programs that have been executed on the file, identifying the file in a table, the table including at least one anti-virus criteria for each identified file, and verifying that the list of one or more anti-virus programs comprised in the virus-free certificate is included in a list of anti-virus programs associated with the file in the table. Applicants submit that the prior art, when considered in combination, fails to disclose all of the features recited in claim 9.

Applicants further assert that there is an insufficient showing in the present §103(a) rejection of objective evidence of record that would motivate one skilled in the art to modify the proposed combination of Touboul '844, Van Oorschot, Hailpern, Touboul '194 and Haber, in order to produce the particular limitations of the claimed invention. The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." *Id.* at 1343-1344. "[T]he mere fact that teachings found in the prior art could be combined as proposed by an examiner does not make the combination obvious 'absent some teaching, suggestion or incentive supporting the combination.'" *Ex parte Metcalf*, 67 USPQ2d 1633, 1635 (citing *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986)).

For at least the reasons stated above, Applicants submit that claims 5, 9 and 11 are believed to be patentable over the prior art of record, not merely by virtue of their dependency from claim 1, but also in their own right. Accordingly, favorable reconsideration and allowance of claims 5, 9 and 11 are respectfully solicited.

Application Serial No. 09/753,773

In view of the foregoing, Applicants believe that pending claims 1-17 are in condition for allowance, and respectfully request withdrawal of the §112 and §103 rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wayne L. Ellenbogen", with a stylized flourish extending from the end.

Date: June 25, 2004

Wayne L. Ellenbogen  
Attorney for Applicant(s)  
Reg. No. 43,602  
Ryan, Mason & Lewis, LLP  
90 Forest Avenue  
Locust Valley, NY 11560  
(516) 759-7662